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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,519	01/29/2004	Marc C. Piscitello	14935US01	5528
23446 7590 06/19/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER CHOI, STEPHEN	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 06/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/767,519

Applicant(s)

PISCITELLO, MARC C.

Examiner

Stephen Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6,10-15,17 and 21-39 is/are pending in the application.
- 4a) Of the above claim(s) 28-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,10-15,17 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 28-39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 28-39 contain non-elected subject matter of the previous restriction requirement.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5-6, 10-15, 17, and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henc (US 3,119,312) in view of McMahon et al. (US 4,640,165).

Henc discloses the invention substantially as claimed including a knife roller (e.g., 14), a cooperating anvil roller (e.g., 24), at least one knife carrying unit comprising a knife holder (e.g., 32) having at least one shaped slot including a component that extends circumferentially such that the slot traverses a non-linear path on the knife roller

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periphery (e.g., Figure 1), and at least one shaped cutting knife (e.g., 24) wherein the knife carrying unit is movable around the circumference of the knife roller (e.g., via 22), Henc fails to disclose the knife holder being formed of a resilient elastomeric material. McMahon discloses a knife holder formed of a resilient elastomeric material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a knife holder formed of a resilient elastomeric material as taught by McMahon on the device of Henc in order to provide a knife holder that absorbs the force placed upon the knife to enhance cutting performance. Regarding claims 5-6, col. 2, lines 51- 53 of McMahon. Regarding claims 14-15, the web material is not part of the invention. It merely recites the manner in which a claimed apparatus is intended to be employed. The modified device of Henc satisfies all the claimed structural limitations thus, capable of cutting the recited web material. Regarding claim 17, the modified device of Henc discloses the invention substantially as claimed except for at least one retaining member and a fastener passing through the retaining member and into receptacles within the knife holder. Instead, the modified device of Henc teaches the use of retainer pins and suitable plastic material. However, McMahon teaches a retention mechanism comprising at least one retaining member and a fastener passing through the retaining member and into receptacles within the knife holder (e.g., 36, 38, 44, 48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a retention mechanism as taught by McMahon the modified device of Henc in order to facilitate replacement of knives. Regarding claims 24-27, it would have been obvious matter of design choice to a person of ordinary skill

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in the art to provide any shape of knife according to the cutting patten desired because applicant has not disclosed that the claimed shape provides an advantage, is used for particular purpose, or solves a stated problem. One of ordinary skill in the art would have provided whatever shaped knife for making desired cuts. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. In re Dailey et al., 149 USPQ 47.

### ***Response to Arguments***

4. Applicant's arguments filed March 19, 2007 have been fully considered but they are not persuasive.

Applicant contends that Henc and McMahon cannot be combined to render claims 1 and 17 obvious because Henc teaches away from using a knife holder formed of an elastic material as taught by McMahon.

The examiner respectfully disagrees. Henc does not teach away from using a holder formed of the elastic material since the proposed examiner's modification of Henc would not have destroyed function of the Henc device. McMahon teaches the use of a knife holder formed of a resilient elastomeric material to absorb impact of a cutting edge against an anvil surface. The resilient elastomeric material can yield in varying degrees depending upon the forces placed upon the cutting edge. In other words, degrees of the forces being absorbed by the resilient elastomeric material depend on various factors (e.g., spacing between the knife roller and the anvil roller, hardness of an anvil surface, characteristics of the workpiece, etc.). Furthermore, McMahon does not preclude the use of his resilient elastomeric material holder with an anvil surface

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formed of resilient material. The device of Henc as modified by the teachings of McMahon would have provided an additional means of absorbing the forces on the cutting edge. Hence, it is the examiner's position that a person of ordinary skill in the art would have been motivated to incorporate the teachings of MaMahon on the device of Henc to arrive at the claimed invention.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Thursday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SC  
10 June 2007

  
**STEPHEN CHOI**  
**PRIMARY EXAMINER**